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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,820	06/15/2001	Peter Stanforth	43940(085610-0109)	7911

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EXAMINER	
PHAN, MAN U	

ART UNIT	PAPER NUMBER
2665	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/882,820	STANFORTH ET AL.	
	Examiner	Art Unit	
	Man Phan	2665	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 August 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Amendment and Argument

1. This communication is in response to applicant's 08/15/2005 Amendment in the application of Stanforth et al. for a "Prioritized-routing for an ad-hoc, peer-to-peer, mobile radio access system based on battery-power levels and type of service" filed 06/15/2001. The proposed amendment to the claims and response have been entered and made of record. Claims 1-20 are pending in the present application.

2. The amended paragraphs in specification correct the status of the patent applications referenced. Therefore, examiner has withdrawn the Objections of record to the specification.

The rejection of record with respect to claims 1, 5, 12, 16 under 35 U.S.C. 112, second paragraph are hereby removed based on applicant's amendment.

3. Applicant's remarks and argument to the rejected claims are insufficient to distinguish the claimed invention from the cited prior arts or overcome the rejection of said claims under 35 U.S.C. 103 as discussed below. Applicant's argument with respect to the pending claims have been fully considered, but they are not persuasive for at least the following reasons.

4. Applicant's argument with respect to the rejected claims that the patent '839 fails to recite the "*transmission of video*". However, the reliance on a commonly known standard such as the use of "*transmitting one of voice-type, video-type or data-type*" in the manner claimed would have been obvious to the artisan as a matter of the Class Of Service (COS) being transmitted in

the communication processing. Furthermore, patent '839 recites in claim 9 for the generating information on the type of message being sent comprising the capability of reporting at least one of the following types of COS information: *voice type information, data type information, and video type information*, whereby routing of a call is based also on the said type of COS information being transmitted. Applicant further asserted that none of the claims of '839 patent recite the selection of a routing path based on bit error rate and latency. However claim 25 of the '839 patent does recite that a routing path is selected based on latency, bit error rate (See also claims 26, 27 of '839 patent). It's noted that in a combined voice-video data transmission system, video packets can be delayed while the voice packets are preferentially transmitted, since the voice packets are more sensitive to transmission delays than the video packets (*routing path selection based on COS priority*). Therefore, examiner maintains that the references cited and applied in the last office actions for the rejection of the claims are maintained in this office action.

Claim Objections

5. Claims 1, 5, 12, 16 objected to because of the following informalities:

The claims contain the phrase "*adapted to*". It has been held that the recitation that an element is "*adapted to*" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. Appropriate correction is required.

Double Patenting

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain : patent therefor ..." (Emphasis added). Thus, the term "same invention" in this context, means an invention drawn to identical subject matter. See Miller v. Eagle Mfg. Co., 151 U.S. 186 (1894); In re Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" ranted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 196%.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37CFR 3.7309.

8. Claims 1-20 are rejected under the judicially created doctrine of double patenting over claims 1-30 of U. S. Patent No. 6,873,839 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are equivalent in scope and embodiment . The language of the two claims is equivalent in functioning. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

With respect to the specific limitations, claims 9, 15, 25-27 of patent 6,873,839 are equivalent to the pending claims 1-4 of Application '820 respectively for the routing a call in an ad-hoc peer-to-peer radio system utilizing the class-of-service, latency (for rapid information access), and bit error rate (for high S/N ratio). The pending claims 6-8, and 13, 17 of Application '820 are equivalent to the claims 6-8 and 17 of patent '839 respectively. All of the structural elements of the patent claims are present in the pending claims, defined with either identical or equivalent language. Additionally, the functional language, although varying in syntax, reflects identical operation, purpose, application, and environment. Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those

of the instant application during prosecution of the application which matured into a patent. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

It's noted that, in a wireless communications network, transmission power is a major component of total energy consumption. Moreover, the energy consumption is proportional to the number of bits transmitted. Therefore, minimizing energy consumption while meeting a predetermined quality of service (QoS) constraint for transmitting multimedia, e.g., still images, videos, voice, text, and data. In general, data to be communicated from a mobile unit to a base station may be assigned a wireless communication priority level corresponding with the service level associated with that mobile unit and communicated to the base station according to the assigned priority level. The service level associated with each mobile unit may specify one or more wireless communication priority levels for one or more various data services, such as video, text, audio and voice services. For example, the service level for a particular mobile unit may establish a relatively low priority level for communicating data files and a relatively high priority level for communicating voice or video data. In particular, the wireless communication priority levels are QoS priority levels as defined by a particular wireless communications standard. For example, the wireless communication priority levels may be QoS priority levels as defined by the CDMA2000 standard.

Regarding claims 5, 9-11 and 12, 14-15 and 16, 18-20, they are system claims, and computer program product for performing the same basis of steps corresponding to the claims 1-

4 as discussed above. Therefore, claims 5, 9-11 and 12, 14-15 and 16, 18-20 are analyzed and rejected as previously discussed with respect to claims 1-4.

Conclusion

9. **THIS ACTION THIS ACTION IS MADE FINAL**. See MPEP ' 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Phan whose telephone number is (571) 272-3149. The examiner can normally be reached on Mon - Fri from 6:00 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu, can be reached on (571) 272-3155. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at toll free 1-866-217-9197.

Mphan

Oct. 27, 2005

MAN U. PHAN
PRIMARY EXAMINER